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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,884	02/26/2002	Vijay Vaidyanathan	2060CIP2CIP	5658

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EXAMINER

BAYAT, BRADLEY B

ART UNIT PAPER NUMBER

3621

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/082,884

Applicant(s)

VAIDYANATHAN ET AL.

Examiner

Bradley B. Bayat

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☒ Claim(s) 2, 4, 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/26/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

This communication is in response to application filed 26 February 2002. Claims 1-42 are presented for examination on the merits.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 26 February 2002 is in compliance with the provisions of 37 CFR 1.97 and therefore considered by the examiner.

Related Applications

Applicant has specified that the instant application is a CIP of 10/032,751 filed 10/27/2001, which is a CIP of application 09/963,812 filed 09/26/2001, which claims benefit of provisional application 60/277,787 filed 03/21/2001.

Unless the filing date of the earlier nonprovisional application is actually needed, for example, in the case of an interference or to overcome a reference, there is no need for the Office to make a determination as to whether the requirement of 35 U.S.C. 120, that the earlier nonprovisional application discloses the invention of the second application in the manner provided by the first paragraph of 35 U.S.C. 112, is met and whether a substantial portion of all of the earlier nonprovisional application is repeated in the second application in a continuation-in-part situation. MPEP 201.08.

However, after reviewing the provisional application submitted by the applicant relating to a peer-to-peer file delivery network in comparison to the instant application disclosure, the examiner notes that the applicant's priority as to the provisional filing date does not apply to

Art Unit: 3621

each and every element of the cited claims. Therefore, in light of the new matter disclosed in the instant continuation-in-part application, the examiner submits the following rejection.

35 USC § 101

As per claims 15-28, applicant indicates a “computer readable medium containing program instructions for enabling electronic delivery of files, the instructions for...” Although the applicant does not specify computer instructions or executable instructions in the language of the above noted claims, the examiner presumes such is the intention of the applicant; thereby meeting the statutory requirements of 35 USC § 101. The applicant is invited to make any corrections to the claims to clarify the above noted presumption.

Specification

The disclosure is objected to because of the following informalities:

- Applicant’s insertion of law firm internal docket numbers (e.g., 2060CIP2, 2060P) following the serial numbers in the “cross-reference to related applications” of the specification should be deleted from the body of the disclosure.
- Specification page 1, lines 20-21 and page 2, lines 1-2 are repetitious.
- Specification page 3, line 11-12 use of double negative in describing need of consumers appears to be a grammatical/typographical mistake.

Appropriate correction is required.

Claim Objections

Claims 2, 4 and 9 are objected to because of the following informalities:

Art Unit: 3621

- Claim 2: "...and an optional retail price and reseller commission" fails to further limit the claim since it is merely an option.
- Claim 4: misspelling of the word "business."
- Claim 9: "allowing the content owner to set the retail price and the reseller commission..." fails to limit the scope of the claim since it does not positively recite this limitation.

The applicant is invited to check all corresponding claims for the above referenced objections and for any typographical/grammatical errors in the claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe (US 2003/0023687 A1) in view of Geravis (Electronic Rights Management and Digital Identifier Systems, March 1999, The Journal of Electronic Publishing, Volume 4, Issue 3, pp.1-25).

1 Wolfe discloses a method for enabling electronic delivery of files in a digital marketplace, the method comprising the steps of:

Art Unit: 3621

(a) maintaining a data repository for storing information relating to the files available in the digital marketplace, including business rules associated with each file that define electronic transfer of the files during commercial transactions (§18, 64);

(b) in response to a first user requesting to resell a particular file and thereby becoming a reseller, using the data repository to dynamically generate a reseller uniform resource locator (RURL) that uniquely identifies the reseller and the file (column 15, lines 21-25);

(c) providing the RURL to the reseller for posting on a website in order to make the file commercially available to others on the website (§16-27); and

(d) in response to a second user clicking on a link to download the file, retrieving from the data repository the business rules associated with the file identified in the RURL to customize the download of the file to the second user and to automatically distribute payments to the reseller (§27, 73-74).

Although Wolfe discloses that any automatic execution can be programmed for processing payments (§83), it does not explicitly disclose automatically distributing payment an owner of the file.

Geravis, however, teaches an electronic rights management and digital identifier system wherein payment can be distributed automatically to content owners through links either directly or through an aggregator of data or third party (i.e., an affiliate or reseller) identifying usage of their files while preserving confidentiality (pp.18-20). In fact, as per applicant's specification on page 6, lines 15-17, applicant gives examples of "content owners" as being "shareware publishers, musicians, artists and designers." Thus, applicant's recited claims merely limit "content owner" to anyone besides a third party reseller or affiliate (specification page 6, lines

Art Unit: 3621

17-18). It would have been obvious to one of ordinary skill in the art at the time of the invention to include automatic disbursement of payment to all parties, including the owner or creator of content for reliable and efficient tracking and reporting of royalties and commissions, as per teachings of Wolfe (¶3-4) and Geravis (pp. 17-22).

2 The method of claim 1 wherein step (a) further includes the step of: providing within the business rules a pricing model associated with the file, and an optional retail price and reseller commission (¶21).

3 The method of claim 2 wherein step (a) further includes the step of: storing a record for each file that includes fields for identifying a location of file and an owner of the file (¶45, 53-55).

4 The method of claim 3 wherein step (a) further includes the step of: providing each record with a file ID, a file name, a content owner ID, metafile information, a fingerprint, and the businesses rules (¶43, 74-77, 85-86).

5 The method of claim 4 wherein step (a) further includes the step of: providing the business rules with a redistributable indicator that indicates whether the file is redistributable (¶27).

6 The method of claim 4 wherein step (a) further includes the step of: using the fingerprint to uniquely identify each file by the content of the file (¶52-62).

Art Unit: 3621

7 The method of claim 6 wherein step (a) further includes the step of: generating a bitstream ID by calculating binary values in data blocks of the file (§68-74).

8 The method of claim 2 wherein step (d) further includes the step of: (i) charging the second user the retail price for downloading the file (§53).

9 The method of claim 8 wherein step (a) further includes the step of: (i) allowing the content owner to set the retail price and the reseller commission both positively and negatively (§21).

10 The method of claim 2 wherein step (b) further includes the step of: (i) providing the RURL with a web address of the marketplace, the file ID, and the user ID of the reseller (§68-75).

11 The method of claim 10 wherein step (b) further includes the step of: (i) providing the RURL by displaying the RURL and allowing the reseller to copy and paste the RURL on the website (§45, 65).

12 The method of claim 10 wherein step (b) further includes the step of: (i) providing the RURL via email (§28, 59, 75).

13 The method of claim 1 further including the step of: implementing the digital marketplace as a website on a network (fig 8 and associated text).

Art Unit: 3621

14 The method of claim 1 further including the step of: implementing the digital marketplace as a peer-to-peer network (§58, 65-72).

Claims 15-28 and 29-42 are respectively directed to a computer readable medium and system of the above recited method claims. Accordingly, claims 15-42 are similarly rejected as detailed above.

Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US Patent 6,029,141 to Bezos et al.
- US Patent 6,282,653 B1 to Berstis et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The

Art Unit: 3621

examiner can normally be reached on Tuesday - Friday 8 a.m.-6:30 p.m. and by email:

bradley.bayat@uspto.gov.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached regarding urgent matters at 571-272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or Faxed to:

(571) 273-8300 - Official communications; including After Final responses.

(571) 273-6704 - Informal/Draft communications to the examiner.

A handwritten signature in black ink, appearing to read 'Bradley Bayat', with a horizontal line extending from the end of the signature.

Bradley B. Bayat, Esq.
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